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Remarks.

A set of claims amended claims is hereby submitted for approval.

The claims pending in examination are dependent claims 12-14 and 16-19 and independent/main claims 20 and 21.

Claims 20 and 21 have been amended as set forth in the listing of the claims.

In particular, "high printability" in claim 20 has been replaced by ~~—suitable for printing—~~, in view of the objection to the term "high" deemed indefinite. The terms ~~—suitable for printing—~~ have been added also in claim 21.

In claims 20 and 21, the second deposition coating and the step for its deposition, sequential to the first deposition step as claimed, have been defined as "external surface coating layer" and as "final coating".

As shown by citation (Wikipedia, for ex.) in the applicant's previous letter of December 2008, *rotogravure or flexography device that has an outer deposition wall provided with a plurality of deposition cells will unambiguously be recognizable by the one skilled in the art as being a technique that is different from and not equivalent with the screen printing using a squeegee blade that is moved across the screen stencil forcing or pumping ink past the threads of the woven mesh in the open area to form an image with a defined contour.*

As set forth in the specification, pages 1-2, lines 25-30 and 1-2, in combination with the teaching of page 4, lines 4-7, 25-27, the external surface coating layer /final step for coating carried out by flexographic or rotogravure device suitable to provide a an external surface pearlescent coating layer, as claimed in claims 20 and 21, achieves the particular

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advantageous effect of providing a final thin ( thickness comprised between 2-6  $\mu\text{m}$ ) pearlescent coating layer, in which the pearlescent pigments advantageously remain in the surface of the paper suitable for printing, the final coating being free from the streaks and/or lines of the prior art products.

It is submitted that a method with the steps as claimed in claim 21 and a paper suitable for printing as claimed in claim 20 are neither disclosed nor rendered obvious by the prior documents of record, taken alone or in combination.

None of the cited prior documents, in particular, discloses or suggests a paper suitable for printing with a rotogravure or flexographic device deposited external surface layer of coating with pearlescent effect located over the at least one first layer and which is constituted by a pearlescent coating layer which has a thickness comprised between 2-6  $\mu\text{m}$ .

Reconsideration of the application as hereby amended is respectfully solicited.

In relation with the Examiner's comments and objections in the outstanding Final Office Action of 03/05/2009, the following is submitted.

Claims 1-11 stand deleted as from the applicant's submission of 12 December 2008.

Accordingly, applicant has not been able to make reference here to the rejection in the Office Action of August 12, 2008, as requested by the Examiner, at par. 2 of the outstanding Final Office Action, since such rejection of 2008 appear to deal with the invention claimed by the applicant in original claims 11 (deleted from December 12, 2008) and 20.

Both such old claims had different scope and were substantially different, as regards steps

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and features. from claims 20 and 21 that were pending in examination at the time when the outstanding Final Office Action has been issued.

Amended claim 20, as amended and presented with the applicant's letter of December 12, 2008 comprised substantial amendments that were not dealt with in detail in the preceding Office Action of August 12, 2008.

In addition, applicant cannot find any bearing in the Office Action of August 12, 2008, to the Examiner's indication that De Bastiani et al and O'Dell et al were used in combination with Wiley et al., since in such Office Action:

-at pars. 4-5, claims 11, 13, 14-15, 19-20 were rejected over Wiley et al. and , respectively, for main claim 20 only, over De Bastiani et al, or O'Dell, under 35 U.S.C. §102, for lack of novelty, and in alternative, for obviousness under §103 (a) over Wiley et al. only with unspecified minor modifications;

-at pars. 6-7, although the factual inquiries for determining obviousness of *Graham v. John Deere* were cited, the rationale directed to main claims 11 , deleted on Dec. 12, 2008, and subclaims 12-19, was construed, or at least so appears, without explicit ascertaining of the differences between the (basic) prior art (Wiley et al. ?) and the claims at issue, since it is not clear to the applicant which features of claim 11 or claim 20 were deemed known from Wiley et al. and which were deemed missing so as to require minor modifications.

Claims 11-19 were deemed rejected under 35 U.S.C. § 103(a) over De Bastiani et al. , or Bourdelais et al. as evidenced by Wiley et al., supra.

Applicant could not however establish from the Office Action of August 2008, which are

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the features of difference between each of the claims, particularly the main claims 11 and 20, and Wiley et al., that the one skilled in the art would find instead disclosed in *De Bastiani et al.*, or *O'Dell et al.*. It was not possible then to establish which may be the related motivations that would prompt the one skilled in the art to modify Wiley et al, in view of the missing features to combine therein the features of difference of *De Bastiani et al.*, or *O'Dell et al.*, all in an obvious, non-inventive manner.

New main claims 20 and 21, as hereby amended, are different in scope with respect to previously submitted claims 20 and 21.

Although three new references are cited on form PTO 892 no discussion/objection was made/raised based thereon in the Final Office Action as regards any possible relevance thereof to the patentability of claims 12-14, 16-21.

Applicant believes that the new claims, herewith enclosed, are allowable.

Favorable action is respectfully solicited.

While it is believed that the amended claims properly and clearly define the present invention, applicant would be open to any suggestion or amendment the Examiner may have or propose concerning different claim phraseology which, in the Examiner's opinion, more accurately defines the present invention.

Respectfully submitted,



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